

U. 48,694

CASE Q211-NP

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Warren K. Volles

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October 29, 2003

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BANVILLE ET AL.

APPLICATION NO: 09/848,694

FILED: MAY 3, 2001

FOR: ALPHA-AMINO, -THIO, -OXO SUBSTITUTED KETONES AS
PHOSPHOLIPASE INHIBITORSRECEIVED
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action dated July 29, 2003 restriction to one of the following groups was required:

- I. Claims 1-9, drawn to compounds, classified in class 564, subclass 305+.
- II. Claim 10, drawn to a method of use, classified in class 514, subclass 646+.

As stated in on page 2 of the Office Action, the Examiner's position is:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product.

However, the Examiner's assertion is unsupported by an example of how the product as claimed can be used in a materially different process. Indeed, the process of Group II i.e., method

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of claim 10, specifically references the compound of claim 1, i.e., the product of Group I. It is respectfully submitted that the U.S. Patent and Trademark Office has failed to meet its burden to support the restriction requirement. Hence, for the foregoing reason, the restriction requirement is traversed.

Notwithstanding the traverse, applicants provisionally elect the invention of Group I, claims 1-9.

Further, applicants elect the species from the structure set forth on page 51, compound titled 3-[4-[3-[N-[2-Bis-(4-chlorophenyl)ethyl]-N-methylamino]propyl]phenoxy]-1-(4-carboxyphenoxy)-2-propanone. Claims 1-4 and 7-10 read on the elected species.

Also filed herewith is a request for extension of time of 2 months.

An early and favorable Office Action is courteously solicited.

Respectfully submitted,

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